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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/801,929 | 03/09/2001 | Charles Patrick Thacker | 03797.00092 | 3449 |
| 28319 | 7590 | 12/23/2005 | EXAMINER | |
| BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET, N.W. Suite 1100 WASHINGTON, DC 20001-4597 | | | NGUYEN, JIMMY H | |
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| | | | 2673 | |
| DATE MAILED: 12/23/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,929

Applicant(s)

THACKER ET AL.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,25,26 and 28-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,25,26 and 28-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 04/19/2005. Claims 1, 4-7, 9, 25, 26, and 28-47 are currently pending in the application. An action follows below:

Claim Objections

2. Claims 1, 5, 25, 26, 29, and 30 are objected to because of the following informalities:

As per claim 1, "or" in line 7 should be changed to --and-- in order to render this claim definite and --said-- should be inserted immediately before "at" in line 9 because there is sufficient antecedent basis for the limitation in the claim.

As per claim 5, "or" in line 4 should be changed to --and-- in order to render this claim definite.

As per claims 25, 26 and 30, "a digitizing pen" should be changed to --said stylus-- because there is sufficient antecedent basis for the limitation in the claim. Additionally to claim 30, --made-- should be inserted immediately before "by" in order to clarify the claimed invention.

As per claim 29, "a predetermined gesture" in line 2 should be changed to --said predetermined gesture-- because there is sufficient antecedent basis for the limitation in the claim (see independent claim 1).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-7, 9, 25, 26, and 28-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims above, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed features, **“receiving a user selection of at least one of a shift function, a control function, and an alternate function and sending a mouse button event modified by the selected function”** recited in independent claims 1 and 5 or **“responsive to a second stylus input, sending a mouse button event modified in accordance with the user-selected keyboard function”** recited in independent claim 32. The original disclosure, specifically page 15, lines 2-6, teaches that a display user interface (300) includes keyboard soft keys such as a CTL key (302), a SHIFT key (303), and an ALT key (304) key, and when a CTL key or SHIFT key, a CTL key or a SHIFT key respectively accompanies the next pen touch. Further, the original disclosure, specifically page 15, lines 16-19, expressly teaches “When one or more of the modifiers CTL 302, SHIFT 303 and ALT 304 is active and a user taps in the pen tip with within BULL’S- EYE 305, UI send a right click event plus the modifier(s) to the window immediately below BULL’S_EYE 305”. However, the original disclosure does not disclose to modify a right click event or a mouse button click in accordance with the keyboard function and to send the modified right click event or the modified mouse button event, as presently claimed.

Additionally to claims 29 and 30, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed features, “a step of comparing the user input with a predetermined gesture, ... the predetermined gesture”, see lines 2-4 of claim 29, and “the user input is an in-air gesture ... writing surface”, see claim 30. The original disclosure, specifically page 13, last line through page 14, line 2, teaches “When the pen touch is **preceded** by a selected in-air gesture, ... Instead, the UI is displayed preferably near the pen tip”, i.e., the pen touch (corresponding to the claimed stylus input of claim 1 or user input of claims 28-30) is **different** from a gesture made by a user’s pen. Further, Fig. 5 and the corresponding description expressly discloses a comparison between a user’s gesture (but not a user input to cause a UI to be displayed) and a predetermined gesture.

Additionally to claim 45, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed feature, “responsive to determining that the predetermined does not precede the stylus input, generating a left button mouse event”. The original disclosure, specifically page 13, last two lines teaches “Preferably, the default event that is sent to an application when the pen touches the writing surface is a “left button down” event”. However, the disclosure does not teach the above underlined feature.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 28-30 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 28-30, it is not clear what the applicant means “responsive to determining that the stylus input is precedent by the predetermined gesture, displaying a user interface” (see lines 5-6 of independent claim 1) and “displaying the user interface in response to receiving a user input” (see line 2 of claim 28), i.e., displaying a user interface in response to determining that the stylus input is precedent by the predetermined gesture or in response to receiving a user input. Additionally to claim 29, it is not clear what the applicant means “responsive to determining that the stylus input is precedent by the predetermined gesture, displaying a user interface” (see lines 5-6 of independent claim 1), “displaying the user interface in response to receiving a user input” (see line 2 of claim 28), or “displaying the user interface in response to receiving the user input if the user input matches the predetermined gesture” (see lines 3-4 of claim 29), i.e., displaying a user interface in response to determining that the stylus input is precedent by the predetermined gesture, in response to receiving a user input **or** in response to receiving the user input if the user input matches the predetermined gesture.

As per claim 41, it is not clear what the applicant means “the step of sending includes sending the mouse button event modified in accordance with the user-selected keyboard function to a running application”, i.e., the step of sending includes sending the mouse button event modified in accordance with the user-selected keyboard function or in accordance to a running application.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Akiyama et al. (US 6,018,336), hereinafter Akiyama.

As per claims 5 and 6, the claimed invention reads on the Akiyama reference as follows:

Akiyama discloses a method (a mouse function emulation method, see col. 1, line 61) for emulating a two-button mouse-type computer input device (a tablet 14 and a LCD 17, see Fig. 1) comprising steps of displaying a user interface (a tool bar 172, see Fig. 3) having a plurality of selectable functions including a plurality of control functions such as “HELP” control function, “MOVE” control function, “RIGHT CLICK” control function (corresponding to the selected function and the bull’s eye function), and more functions (see Fig. 3, col. 6, lines 1-2); receiving a user selection of “RIGHT CLICK” function via a pen 15 (see Fig. 1, col. 3, lines 21-22) after the computer input device (14, 17) being placed in a default mode (see col. 3, lines 57-67); and sending a right button event or a mouse button event modified by the selected function (“RIGHT CLICK” function). Accordingly, the steps in the claims are read in the Akiyama reference.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1, 4, 7, 9, 25, 26, 28, 29, 31-38, and 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama and further in view of Moran et al. (US 5,500,935), hereinafter Moran.

As per claims 1, 9, 28, 31, 32, 36, 37, 41-44, 46, and 47, Akiyama teaches a stylus-based computer (as shown in Fig. 1) comprising a two-button mouse-type input device (a tablet 14 and a LCD 17, see Fig. 1) and a method (a mouse function emulation method, see col. 1, line 61) for emulating a two-button mouse-type input device (14, 17) comprising steps of receiving a stylus input from a user (a tap on a dedicated mode change icon, see col. 4, lines 9-10); responsive to the stylus input, displaying a user interface (a tool bar 172, see Fig. 3) having a plurality of selectable functions including a plurality of control functions such as “HELP” control function (this may be considered as a keyboard function), “MOVE” control function (this may also be considered as a keyboard function), “RIGHT CLICK” control function, and more functions (see Fig. 3, col. 4, lines 7-13, col. 6, lines 1-2); receiving a user selection of “RIGHT CLICK” function via a pen 15 (see Fig. 1, col. 3, lines 21-22) after the computer input device (14, 17) being placed in a default mode (see col. 3, lines 57-67); and sending a right button event or a mouse button event modified by the selected function (“RIGHT CLICK” function). Further, Akiyama teaches the computer system comprising a CPU 11 for controlling the entire system and for executing the process for emulating a plurality of mouse functions, a RAM 12 for storing various kinds of application programs executed by the CPU (see Fig. 1, col. 3, lines 1-18). Akiyama also teaches that each mode can be locked or unlock depending on the interaction of the user (column 53-59). Accordingly, Akiyama discloses all the claimed limitations except that Akiyama does not disclose the stylus input preceded by a predetermined gesture (see

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independent claims 1 and 32). However, Moran discloses that both the concept and the advantages of providing a gesture before a stylus input in order to designate an action for the system to perform are well-known and expected in the art (col. 1, line 53 through col. 2, line 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide a gesture before a stylus input in the method of Akiyama, in view of the teaching in the Moran reference, because this would designate an action for the system based upon on the predetermined gesture, as taught by Moran, thereby avoiding an unwanted activation of the user interface due to an accidental tap on the mode change icon.

As per claims 4, 7, and 40, as discussed above, Akiyama in view of Moran discloses all the claimed limitations of these claims except for a step of hiding the user interface responsive to receiving a use selection, of claims 4 and 40, or the steps of starting an inactivity timer when the user interface is displayed and hiding the user interface when a predetermined amount of time elapses without receiving the user selection, of claim 7. However, Official Notice is taken that both the concept and the advantages of providing steps of hiding the user interface responsive to receiving a use selection and starting an inactivity timer when the user interface is displayed and hiding the user interface when a predetermined amount of time elapses without receiving the user selection, in order to provide more room for other user interface or windows are well-known and expected in the art. Therefore, it would have been obvious to provide steps of hiding the user interface responsive to receiving a use selection and starting an inactivity timer when the user interface is displayed and hiding the user interface when a predetermined amount of time elapses without receiving the user selection, in the method of Akiyama, because this would provide more room for other user interface or windows.

As per claims 25, 26, and 38, as seen from figures 3 and 4 in the Akiyama reference, Akiyama teaches that the location of a user interface (172) is static and does not depend upon a location of the stylus. Accordingly, Akiyama does not disclose expressly the location of the user interface depending upon the location of the stylus. However, Moran teaches in column 1, lines 65-67, "With menu functions, a visible menu is either located on a specified area of a display or appears near the stylus position when desired (pop-up menu)", i.e., the location of the user interface depending upon the location of the stylus. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to utilize the teaching of Moran, i.e., providing the location of the user interface depending upon the location of the stylus, in the method of Akiyama, because one skilled in the art would recognize that this would reduce the amount of travel time required to invoke the new function mode displayed in the user interface.

In reference to claim 29, as noting in col. 1, line 53 through col. 2, line 29, Moran teaches the step of displaying including an inherent step of comparing the user input with a predetermined gesture in order to display the user interface.

As per claims 33-35, as discussed in the rejection to claim 32 above, Akiyama discloses a plurality of selectable functions including "HELP" control function (this may be considered as a keyboard function), "MOVE" control function (this may be considered as a keyboard function), "RIGHT CLICK" control function, and more functions (see Fig. 3, col. 4, lines 7-13, col. 6, lines 1-2). Accordingly, the difference between the invention defined by these claims and the invention of Akiyama in view of Moran is that Akiyama does not explicitly teach that the selectable functions including a Shift, Control, or Alternate key function. However, Akiyama

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further teaches “However, the other mouse functions can be emulated by increasing the selection button of the other mouse functions” (see col. 6, lines 1-2 and lines 38-43). Therefore, while Akiyama may not exemplify particular selectable key function being a Shift, Control, or Alternate key function, one of ordinary skill in the art would have found it obvious to provide a Shift, Control, and/or Alternate key function(s) in the user interface of Akiyama in accordance with a particular application and an allusion of Akiyama (see col. 6, lines 29-53).

As per claim 45, Akiyama further teaches that, when there is no instruction for changing modes, user input corresponds to the click of the left side mouse button (see col. 3, lines 58-67).

11. Claims 30 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama in view of Moran and in further view of Levine et al. (US 5,625,833), hereinafter Levine.

As per claims 30 and 39, as discussed above, Akiyama in view of Moran discloses all the claimed limitations except that Akiyama in view of Moran does not expressly teach the gesture being an in-air gesture, as presently claimed. However, Levine teaches that in a stylus/tablet input device, the gesture includes the movement of the stylus in the air (column 6, lines 27-33), i.e., the use of an in-air gesture in the stylus/tablet input device. Therefore, it would have been obvious to utilize the in-air gesture in the method of Akiyama, in view of the teaching in the Levine reference, because this would avoid the stylus in contact with the tablet during making a gesture, thereby avoiding an unwanted activation of other functions, menus, or other application being displayed in the display area.

Response to Arguments

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12. Applicant's arguments with respect to claims 1, 4-7, 9, 25, 26, and 28-47 have been considered but are moot in view of the new ground(s) of rejection above.

Conclusion

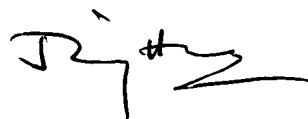
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675.

The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN
December 21, 2005



Jimmy H. Nguyen
Primary Examiner
Art Unit: 2673